

REMARKS

By this Amendment, Applicants amend claim 1, 3, 5-8, 11, 13, 15, 17-28, 30, 32-35, and 38, and add new claims 39-46. Claims 1-13, 15, and 17-46 are now pending in this application.

In the Office Action,¹ the Examiner provisionally rejected claims 1-13, 15, and 17-38 on the ground of non-statutory obviousness-type double patenting; objected to the specification under 35 U.S.C. § 132(a) for introducing new matter; rejected claims 13, 15, and 17-38 under 35 U.S.C. § 101 as being directed to non-statutory subject matter; rejected claims 11, 26, and 38 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement; rejected claims 7, 8, 22, 23, 34, and 35 under 35 U.S.C. § 112, second paragraph, as being indefinite; rejected claims 1, 3-13, 15, 18-28, and 30-38 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,548,750 to Larsson et al. ("Larsson") in view of U.S. Publication No. 2003/0004975 to Nakano ("Nakano"); and rejected claims 2, 17, and 29² under 35 U.S.C. § 103(a) as being unpatentable over Larsson in view of Nakano and U.S. Patent No. 6,944,615 to Teng et al. ("Teng").

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

² Applicants believe the Examiner erroneously stated that claims 2, 15, and 24 are rejected under 35 U.S.C. § 103(a) over Larsson in view of Nakano and Teng in light of the rejection of claims 2, 17, and 29 discussed in pages 13-14 of the Office Action.

I. Provisional Non-Statutory Obviousness-Type Double Patenting Rejections

Applicants respectfully traverse the provisional rejections of claims 1-13, 15, and 17-38 over copending U.S. Application Nos. 10/526,504 and 10/526,747, and request that the provisional rejections be held in abeyance.

Both the copending applications are currently pending and, thus, no double patenting circumstances can arise until a patent is granted. Because no patent has yet issued from the two copending applications, Applicants respectfully request that the provisional rejections be held in abeyance and any resolution in the form of a terminal disclaimer or otherwise be deferred.

Applicants further note that M.P.E.P. § 804, 8th Ed., Rev. 6 (Sept. 2007), addresses the situation of copending applications. Section 804 indicates that “[t]he ‘provisional’ double patenting rejection should continue to be made by the examiner in each application . . . unless that ‘provisional’ double patenting rejection is the only rejection remaining in at least one of the applications. . . . If a ‘provisional’ statutory double patenting rejection is the only rejection remaining in one of the applications . . . , the examiner should withdraw the rejection in that application and permit that application to issue as a patent, thereby converting the ‘provisional’ double patenting rejection in the other application into a double patenting rejection when the application issues as a patent.” M.P.E.P. § 804(I)(B). Therefore, Applicants request that the provisional non-statutory obviousness-type double patenting rejections be withdrawn should they be the only remaining rejections in this application and none of the copending applications has issued as a patent.

II. Objection to the Specification Under 35 U.S.C. § 132(a) and Rejection of Claims 11, 26, and 38 Under 35 U.S.C. § 112, First Paragraph

Applicants respectfully traverse the objection to the specification under 35 U.S.C. § 132(a) and the rejection of claims 11, 26, and 38 under 35 U.S.C. § 112, first paragraph. However, to advance prosecution, Applicants amend claims 11, 26, and 38 to address the Examiner's concerns over new matter and the written description requirement. Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw the objection to the specification under 35 U.S.C. § 132(a) and the rejection of claims 11, 26, and 38 under 35 U.S.C. § 112, first paragraph.

III. Rejection of Claims 13, 15, and 17-38 Under 35 U.S.C. § 101

Applicants respectfully traverse the rejection of claims 13, 15, and 17-38 under 35 U.S.C. § 101.

The Examiner alleges that the "computer system" of claims 13 and 28-33 "could reasonably [be] interpret[ed] . . . as software[] per se." Office Action at 5. However, claim 13 recites a "computer system comprising . . . a processor," which is a hardware element. For at least this reason, claim 13 is not software *per se* and contains statutory subject matter. Moreover, although claims 28-38 are statutory, to advance prosecution, Applicants amend independent claim 28 to include a "processor."

Furthermore, the Examiner alleges that "claim[s 15 and 17-27 are] drawn to a form of energy." *Id.* Although the Examiner's allegation is incorrect, to advance prosecution, Applicants amend claims 15 and 17-27 to recite a "computer readable storage medium."

Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claims 13, 15, and 17-38 under 35 U.S.C. § 101.

IV. Rejection of Claims 7, 8, 22, 23, 34, and 35 Under 35 U.S.C. § 112, Second Paragraph

Applicants respectfully traverse the rejection of claims 7, 8, 22, 23, 34, and 35 under 35 U.S.C. § 112, second paragraph, as being indefinite. However, to advance prosecution, Applicants amend claims 7, 22, and 34 to address the Examiner's concerns.

Regarding claims 8, 23, and 35, which recite "if the ID has been stored [in the first lock object], [then] skip[] storing the data object at the second storage location," the Examiner asks whether "this means that the data object will never be stored in the second storage location?" *Id.* at 7. The Examiner states that a "[c]larification is needed." *Id.* In response, Applicants respectfully draw the Examiner's attention to an exemplary embodiment of the claimed invention disclosed in the specification at page 12, lines 15-19 and page 13, lines 1-19. Applicants further explain that, in accordance with an exemplary embodiment of the claimed invention, if a process determines that the ID is stored in the first lock object, then the process does not move the data object from the first storage location to the second storage location because another process is performing some action on the data object. Applicants submit that claims 8, 23, and 35 are sufficiently definite in view of the specification.

Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claims 7, 8, 22, 23, 34, and 35 under 35 U.S.C. § 112, second paragraph.

V. Rejection of Claims 1, 3-13, 15, 18-28, and 30-38 Under 35 U.S.C. § 103(a)

Applicants respectfully traverse the rejection of claims 1, 3-13, 15, 18-28, and 30-38 under 35 U.S.C. § 103(a) as being unpatentable over *Larsson* in view of *Nakano*. A *prima facie* case of obviousness has not been established.

“The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious.” M.P.E.P. § 2142(III). “[T]he framework for objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). . . . The factual inquiries . . . are as follows:

(A) [Determining the scope and content of the prior art;]

(B) Ascertaining the differences between the claimed invention and the prior art; and

(C) Resolving the level of ordinary skill in the pertinent art.”

M.P.E.P. § 2141(II). “Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.” M.P.E.P. § 2141(III).

Independent claim 1, as amended, recites a method for moving data objects comprising, for example, “determining whether the ID is stored successfully in the second lock object and, upon a successful storage, storing the ID in a first lock object, thereby indicating that the data object is stored at the first storage location” and “deleting the ID from the first lock object, thereby indicating that the data object is not stored at the first storage location.”

Larsson discloses that “there [are] two transaction logs: one . . . []old[] transaction log containing . . . changes . . . which . . . will be reflected in the backup, and a new transaction log containing . . . changes . . . which . . . will not be reflected by the backup. . . . Copying objects to the backup area will . . . not start until the local data base handler has made all changes from transaction to be included in the backup.” *Larsson*, col. 6, lines 3-16. *Larsson* further discloses that “local backup handlers, when the number of transactions in the old transaction log is zero[,] . . . begin copying objects to be included in the backup to the backup area.” *Id.*, col. 3, lines 44-49. “If [the BackupSynch variable in the LID table] is equal to ‘include’ [then] the object will be copied to the backup area, [but] if [the BackupSynch variable] is equal to ‘exclude’ [then] the object will not be copied.” *Id.*, col. 8, lines 7-10.

However, no transaction log or variable in *Larsson* “indicat[es] that the data object is stored [or not stored] at the first storage location,” as recited in claim 1. Therefore, *Larsson* fails to disclose or suggest “storing the ID in a first lock object, thereby indicating that the data object is stored at the first storage location” and “deleting the ID from the first lock object, thereby indicating that the data object is not stored at the first storage location,” as recited in claim 1.

Moreover, *Nakano* fails to cure the deficiencies of *Larsson*. The Examiner alleges that para. [0104] of *Nakano* discloses the claimed “deleting the ID from the permanent type lock object.” Office Action at 9. *Nakano* discloses that “[t]he DBMS executer . . . executes data insert operation and informs the DBMS acceptance section 600 of its insert completion The DBMS acceptance section 600 accepts a notification indicative of the data insert completion and issues a delete request to delete

the insert original data." *Nakano*, para. [0104]. However, the cited portion and any other portion of *Nakano* fail to disclose any lock object that "indicat[es whether] the data object is stored at the first storage location," as recited in claim 1. In addition, although para. [0139] of *Nakano* discloses a "during-rebalancing flag 634 . . . [indicating] whether or not the rebalance operation is being executed," nothing in *Nakano* can constitute a teaching or suggestion of "storing the ID in a first lock object, thereby indicating that the data object is stored at the first storage location" and "deleting the ID from the first lock object, thereby indicating that the data object is not stored at the first storage location," as recited in claim 1.

For at least the foregoing reasons, the scope and content of the prior art have not been properly determined, and the differences between the prior art and claim 1 have not been properly ascertained. Accordingly, no reason has been clearly articulated as to why the prior art would have rendered claim 1 obvious to one of ordinary skill in the art. Therefore, a *prima facie* case of obviousness has not been established with respect to claim 1.

Furthermore, independent claims 13, 15, and 28, although different in scope from claim 1, are allowable for at least reasons similar to those given for claim 1. Additionally, dependent claims 3-12, 18-27, and 30-38 are allowable at least due to their dependence from allowable base claims 1, 15, or 28. Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claims 1, 3-13, 15, 18-28, and 30-38 under 35 U.S.C. § 103(a).

VI. Rejection of Claims 2, 17, and 29 Under 35 U.S.C. § 103(a)

Applicants respectfully traverse the rejection of claim 2, 17, and 29 under 35 U.S.C. § 103(a) as being unpatentable over *Larsson* in view of *Nakano* and *Teng*. A *prima facie* case of obviousness has not been established.

Claims 2, 17, and 29 depend from independent claims 1, 15, and 28, respectively, and thus require all the elements thereof. As discussed above, *Larsson* and *Nakano* fail to render obvious all the elements of claims 1, 15, and 28. Regardless of whether the Examiner's characterization of *Teng* in the Office Action is correct, *Teng* fails to cure the above-noted deficiencies of *Larsson* and *Nakano*. Therefore, the prior art fails to establish a *prima facie* case of obviousness with respect to claims 2, 17, and 29. Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claims 2, 17, and 29 under 35 U.S.C. § 103(a).

CONCLUSION

In view of the foregoing, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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